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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,929

09/18/2003

Victor L. Andelin

P0881D

6471

23735 7590 10/13/2010  
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EXAMINER

CERVETTI, DAVID GARCIA

ART UNIT

PAPER NUMBER

2436

MAIL DATE

DELIVERY MODE

10/13/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,929	<b>Applicant(s)</b> ANDELIN ET AL.	
	<b>Examiner</b> David García Cervetti	<b>Art Unit</b> 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendment and Appeal Brief filed 7/19/2010 have been fully considered.
2. Claims 14-48 are pending and have been examined. Claims 1-13 have been canceled.

### ***Response to Amendment***

3. In view of the appeal brief filed on 7/19/2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

4. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Nasser Moazzami/

Supervisory Patent Examiner, Art Unit 2436

5. The requirement for information still stands. Applicant is required to present the requested information. Examiner will determine if the requested information is prior art.

6. Regarding claim 35, Examiner respectfully points out that Wu teaches linked watermarks, information in a first portion of a document is embedded as a first watermark in a second portion, and then information from a second portion is embedded in a third portion. This, as stated, suggests that after the first watermark is embedded, the second watermark is created, necessarily including a portion of the first (i.e. reduced bit-representation) watermark. Fig. 1 points to using identification information (document identifier) from portion 1 into watermark embedded into portion 2.

7. Regarding claim 22, please refer to office action dated 1/21/2009 for the Official Notice and office action dated 8/25/2009 for changing the official notice to admitted prior art since applicant did not adequately challenge the use of official notice (MPEP 2144.03(c), 2144.04).

8. Further, regarding claim 22, Wu teaches information about a user and the passport identifier uniquely identifies the person (not 2 passport numbers are given to the same person or different persons).

9. Assuming arguendo Wu does not teach any of the above, Examiner introduces Carr (6389151) for a passport identifier embedded as watermark over a photo and scanning of the passport to determine validity (scanning of the photo would also determine validity) (col.3-4). Likewise, a driver's license number can be embedded as watermark over the image of the person, a number can be embedded as watermark over something else on another official document. The claim sets to perform the same as the prior art for a different document, one authenticates documentation associated with a person, the other, with a motor vehicle.

***Requirement for Information***

10. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: "Digimarc's Digital Driver's License/ ID card System". A white paper, user manual, and/or other relevant documents are respectfully requested.

11. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

***Claim Rejections - 35 USC § 102***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**13. Claims 35, 38, and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu (6748533).**

**Regarding claim 35, Wu teaches**

a printed document comprising (abstract, passport): a document identifier (fig.1, id portion); a first digital watermark including a first payload, the first payload comprising a representation of the document identifier; a second digital watermark including a second payload, the second payload comprising at least a reduced-bit representation of the first payload (col.6, lines 35-67, information from one part of the document embedded as invisible or visible watermark on a second portion, and this data in a third portion).

**Regarding claim 38**, Wu teaches wherein the document comprises information printed therein, and wherein said second payload further comprises a representation of at least a portion of the printed information (col.6, lines 35-67).

**Regarding claim 40**, Wu teaches wherein the reduced-bit representation of the first payload comprises a hash (col.5-6).

**Regarding claim 41**, Wu teaches wherein the reduced-bit representation of the first payload comprises a cryptographic permutation (col.5-6).

**Regarding claim 42**, Wu teaches wherein the document comprises variable information printed thereon, and wherein the second digital watermark comprises at least some of the variable information, wherein the variable information varies from document to document (col.5-6).

***Claim Rejections - 35 USC § 103***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**15. Claims 22-25, 39, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu.**

**Regarding claim 22**, Wu teaches a method to authenticate documentation associated with a person, the documentation comprises plural-bit auxiliary data steganographically embedded therein through alterations to graphics, artwork or information carried on the documentation, the auxiliary data comprising at least an identifier (abstract, passport information), said method comprising: receiving optically captured image data that corresponds to the documentation; utilizing a configured multi-purpose electronic processor analyzing the image data to obtain the identifier, wherein the identifier includes or links to information to uniquely identify the person; and providing a signal in response to the identifier being obtained (abstract, scan watermark to determine authenticity).

Wu does not expressly disclose documentation associated with a motor vehicle comprising such features, however, these features have been admitted per applicant to have been conventional and well known at the time the invention was made.

**Regarding claim 23**, Wu teaches wherein the identifier is intertwined with another identifier, the another identifier being steganographically embedded in different documentation, the different documentation also being associated with a motor vehicle (col.5-6).

**Regarding claim 24**, Wu teaches wherein the documentation comprises at least one of an emissions document or sticker, a license plate, an insurance card, disabled

placard, cab or taxi documentation, a trip permit, a cargo manifest, a registration document, an inspection sticker or document, or and a motor vehicle title (col.5-6).

**Regarding claim 25**, Wu teaches wherein the information further comprises a listing of drivers who are authorized to operate the motor vehicle (col.5-6).

**Regarding claim 39**, Wu does not expressly disclose, however, these features have been admitted per applicant to have been conventional and well known at the time the invention was made.

**Regarding claims 45-46**, Wu a programmed computing device storing instructions in memory, said instructions are executable by said programmed computing device to perform the acts of claim 22 / a computer readable media comprising instructions stored thereon to cause a multi-purpose electronic processor to perform the acts of claim 22 (abstract, col.2-3, summary).

**16. Claims and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, and further in view of Bunn (6907528).**

**Regarding claims 36-37**, Wu does not expressly disclose, however Bunn teaches wherein the document is associated with a motor vehicle / wherein the document identifier comprises a vehicle identification number (VIN) (col.3, lines 20-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Wu's teachings on the system of Bunn. One of ordinary skill in the art would have been motivated to perform such a modification to provide multiple watermarks to motor vehicle related documents (Bunn, col.3).

***Allowable Subject Matter***



Art Unit: 2436

17. Claims 14-21, 26-34, 43-44, and 47-48 would be allowed.

18. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

### ***Conclusion***

19. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David García Cervetti whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nasser Moazzami/

Supervisory Patent Examiner, Art Unit 2436

/David García Cervetti/

Primary Examiner, Art Unit 2436